



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SM

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/003,812 01/07/98 BAN

S 041-1987

022429
LOWE HAUPTMAN GOPSTEIN
GILMAN AND BERNER LLP
SUITE 310
1700 DIAGONAL ROAD
ALEXANDRIA VA 22314

WM01/0118

EXAMINER

GRIER, L

ART UNIT

PAPER NUMBER

2644

DATE MAILED:

01/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Regards,
Laura A. Grier
(703) 306-4819

BEST AVAILABLE COPY

2

Office Action Summary

Application No.

09/003,812

Applicant(s)

BAN ET AL.

Examiner

Laura A. Grier

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. **Claims 1-2 and 4-5** are rejected under 35 U.S.C. 102(e) as being anticipated by anticipated by Tuoriniemi et al. (U. S. Patent No. 5978689).

Regarding **claim 1**, Tuoriniemi et al. discloses a personal portable communication and audio system. Tuoriniemi et al.'s disclosure comprises a connector (figure 5-reference 88) for an audio device (figure 5-reference 68), and a connector (figure 5-reference 26) for a cellular telephone (figure 5-reference 22), both connected to a headset, which reads on a first plug with disconnectable connection with the audio device and with the portable communication device; a speaker (figure 5-reference 18 or 20), which reads on an electroacoustical transducer; and inherently teaches means for controlling the signal level of the devices (column 4, lines 59-67 and column 5, lines 1-2 and 25-28).

Regarding **claim 2**, Tuoriniemi et al. discloses everything claimed as applied above (see claim 1). Tuoriniemi et al. further discloses a telephone ring alert signal for detecting a call and/or output from the cellular telephone, a microcontroller, and a off-

Art Unit: 2644

hook detector provide capabilities of disabling the audio connection to receive the incoming call of the portable communication device columns 6-7, lines 55-49).

Regarding **claim 4**, Tuoriniemi et al. discloses everything claimed as applied above (see claim 1). Tuoriniemi et al. further discloses (references 12 and 16) a microphone and a switch (column 9, 1st paragraph).

Regarding **claim 5**, Tuoriniemi et al. discloses everything claimed as applied above (see claim 2). Tuoriniemi et al. further discloses (references 12 and 16) a microphone and a switch (column 9, 1st paragraph).

3. **Claim 6** is rejected under 35 U.S.C. 102(e) as being anticipated by anticipated by Tuoriniemi et al.

Regarding **claim 6**, Tuoriniemi et al. discloses a personal portable communication and audio system. Tuoriniemi et al.'s disclosure comprises a connector (figure 5-reference 88) for an audio device (figure 5-reference 68) , and a connector (figure 5-reference 26) for a cellular telephone (figure 5-reference 22), both connected to a headset, which reads on a first plug with disconnectable connection with the audio device and with the portable communication device; a speaker (figure 5-reference 18 or 20), which reads on an electroacoustical transducer; and microcontroller (reference 49) with automatic muting capabilities (column 7, lines 3-6 and 49-51), which constitutes means of increasing one signal while decreasing another.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuoriniemi et al. in view of Slater (U. S. Patent No. 4941187).

Regarding **claim 3**, Tuoriniemi et al. discloses everything as applied above (see claim 2). However, Tuoriniemi et al. fails to specifically disclose means of regulating/controlling the signals at predetermined reference levels. The examiner maintains that the means of regulating/controlling signals for predetermined reference levels was well known in the art, as taught by Slater.

Regarding the predetermined reference levels, in a similar field of endeavor, Slater discloses an intercom apparatus for integrating disparate audio sources for use in light aircraft or similar high noise environments. Slater disclosure teaches means for regulating the signal level at predetermined stages (columns 10, lines 44-56).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Tuoriniemi et al. by providing means of regulating the signal level at predetermined levels for the purpose of effectively and cautiously controlling the operation and function of the devices during different phase of operation when the portable communication device is in use.

5. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuoriniemi et al. in view of Lansang (U. S. Patent No. 5794127).

Regarding claim 7, Tuoriniemi et al. discloses everything claimed as applied above (see claim 1). However, Tuoriniemi et al. fails to disclose the means of controlling the level of the first signal being separate from the two devices. The examiner maintains that disclosing such means of controlling the level of signal was well known in the art, as taught by Langsang.

Regarding the separate control means, in similar field of endeavor, Lansang discloses a headphone remote control for operating an entertainment center. Lansang's disclosure includes means of controlling the volume on the headphones (figure 3-reference 16 and column 5, lines 26-34), which reads on the means of controlling the level of the signal being separate from the device(s).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Tuoriniemi et al. by providing the control means for the level of the signal separate from both the audio device and the telephone for the purpose of being able to remotely control the volume of the signal.

Response to Arguments

Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Art Unit: 2644

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura A. Grier whose telephone number is (703) 306-4819. The examiner can normally be reached between 7:30 am. – 4:00 p.m., Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6306 for regular communications and (703) 308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

LAG 
January 16, 2001


FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700